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EXAMINER
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VU, THONG H

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/686,255

Applicant(s)

MANBER ET AL.

Examiner

Thong H. Vu

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 7-14, 17-25, 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-14, 17-25, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. Claims 1-4,7-14,17-25,27-28 are pending. Claims 5-6,15-16, 26 are canceled.

***Priority***

2. This is a Continuation application 09/510,201 filed on 2/22/2000 now USP 6,651,086. This Office Action response to the Amendment After Final filed 02/02/06.

***Response to Amendment***

3. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

A new Final Action is follow:

***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-28 are rejected under the judicially created doctrine of double patenting over claims 1-23 of U. S. Patent No. 6,651,086 B1since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

('086) 1. A method, in a messaging server, of connecting parties with mutual interests, comprising the steps of: presenting a media object to a first user; receiving a first comment from the first user; presenting the media object and the first comment to a second user such that the first comment and the media object are displayed proximal each other to the second user; receiving a reply comment from the second user responsive to the first comment; presenting the reply comment to the first user, wherein the first and second user are not connected in an instant messaging session; and thereafter if the reply comment fits a matching criteria, connecting the first and the second user in an instant messaging session.

2. the matching criteria is in the form of an approval indication of the reply comment received from the first user.

3. the media object includes one, or a combination, of a video clip, an audio clip, a graphic or a text object.

4. presenting the media object and the first comment to a third user and subsequent users until a predetermined display count is reached; presenting the first user with reply comments received from the third or subsequent users; and if any of the reply comments from the third or subsequent users are accepted by the first user, connecting the users having made acceptable reply comments to the instant messaging session.

5. the predetermined display count is a function of a parameter settable by the first user.

6. a plurality of media objects are associated with nodes in a hierarchical topic network and comments accepted are associated with the nodes.

7. receiving an association from the first user associating the first comment with one of the nodes; and presenting users' subsets of comments that are associated with a subset of the nodes.

8. limiting the subset of nodes to one parent node and the nodes that are descendants of the one parent node.

9. a plurality of media objects are associated with a concept, and wherein comments received are associated with one of the concept and a specific one of the plurality of media objects.

(Application) 1. A method, in a messaging server, of connecting parties with mutual interests, comprising the steps of: presenting a media object to a first user; accepting a first comment from the first user; presenting the media object to a second user along with the first comment; accepting a reply comment from the second user; and if the reply comment fits a matching criteria, connecting the first and the second user in a messaging session.

2. the matching criteria is in the form of an approval indication by the first user of the reply comment.

3. the media object includes one, or a combination, of a video clip, an audio clip, a graphic or a text object.

4. presenting the media object and the first comment to a third user and subsequent users until a predetermined display count is reached; presenting the first user with reply comments accepted from the third or subsequent users; and if any of the reply comments from the third or subsequent users are accepted by the first user, connecting the users having made acceptable reply comments to the messaging session.

7. the predetermined display count is a function of a parameter settable by the first user.

8. a plurality of media objects are associated with nodes in a hierarchical topic network and comments accepted are associated with the nodes.

9. accepting an association from the first user associating the first comment with one of the nodes; and presenting users' subsets of comments that are associated with a subset of the nodes.

10. limiting the subset of nodes to one parent node and the nodes that are descendants of the one parent node.

11. a plurality of media objects are associated with a concept, and wherein comments accepted are associated with one of the concept and a specific one of the plurality of media objects.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4,7-14,17-25,27-28 are rejected under 35 U.S.C. § 10(e) as being anticipated by Achacoso et al [Achacoso 6,161,149]
6. As per claim 1, Achacoso discloses a method, in a messaging server [Achacoso HTTP server, STMP server, Fig 5], of connecting parties with mutual interests, comprising the steps of:  
  
providing a media object to be display to a first user [Achacoso, a videoconference, col 6 lines 1-17; display the question, col 7 lines 9-20, Fig 3];

receiving a first comment from the first user [Achacoso, person 1 submits input comment D, col 7 lines 34-46, Fig 4A-4B];

providing the media object to be display to a second user along with the first comment [Achacoso, person 1 submits input comment D, col 7 lines 34-46, Fig 4A-4B];

receiving a reply comment from the second user [Achacoso, a response and comment to other members, col 7 lines 22-34, Fig 3C]; and

wherein the first user and second user are not connected in an instant messaging session if the reply comment fits a matching criteria, **automatically** connecting the first and the second user in an instant messaging session (i.e.: chat session) [Achacoso, a chat server, col 10 line 46; Fig 5, col 14 lines 20-50].

7. As per claim 2, Achacoso discloses the matching criteria is in the form of an approval indication by the first user of the reply comment [Achacoso, a response and comment to other members, col 7 lines 22-34, Fig 3C].

8. As per claim 3, Achacoso discloses the media object includes one, or a combination, of a video clip, an audio clip, a graphic or a text object [Achacoso, text,video,audio,graphics, col 7 lines 9-20].

9. As per claim 4, Achacoso discloses presenting the media object and the first comment to a third user and subsequent users until a predetermined display count is reached; presenting the first user with reply comments accepted from the third or

subsequent users; and if any of the reply comments from the third or subsequent users are accepted by the first user, connecting the users having made acceptable reply comments to the messaging session [Achacoso, col 7 lines 9-47, Fig3A-C,4A-B].

10. As per claim 7, Achacoso discloses the predetermined display count is a function of a parameter settable by the first user [Achacoso, videoconference, col 6 lines 6].

11. As per claim 8, Achacoso discloses a plurality of media objects are associated with nodes in a hierarchical topic network and comments accepted are associated with the nodes [Achacoso, Internet, Fig 5].

12. As per claim 9, Achacoso discloses accepting an association from the first user associating the first comment with one of the nodes; and presenting users subsets of comments that are associated with a subset of the nodes [Achacoso, set or subset, col 5 lines 60-67].

13. As per claim 10, Achacoso discloses limiting the subset of nodes to one parent node and the nodes that are descendants of the one parent node [Achacoso, set or subset, col 5 lines 60-67].

14. As per claim 11, Achacoso discloses a plurality of media objects are associated with a concept, and wherein comments accepted are associated with one of the concept and a specific one of the plurality of media objects [Achacoso, Internet, Fig 5].

15. Claims 12-14,17-21 contain the similar limitations as the claims 1-4,7-11. Thus claims 12-14,17-21 are rejected by the same rational set forth claims 1-4,7-11.

16. Claim 24 contains the similar limitations as the claim 1. Thus claim 24 is rejected by the same rational set forth claim 1.

17. As per claim 22, Achacoso-Shtiveman disclose the media object includes a link to the first comment [Achacoso, a web page with URL, col 4 lines 39-52].

18. As per claims 23,25 Achacoso-Shtiveman disclose the second user selecting the link, wherein selection of the link provides a list of one or more comments including the first comment [Achacoso, a list server, col 7 lines 49-67, Fig4-B].

19. As per claim 27, Achacoso-Shtiveman disclose providing the first comment to the second user in response to a search inquiry entered by the second user [Achacoso, col 7 lines 9-45].



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20. As per claim 28, Achacoso-Shtiveman disclose the search inquiry is a keyword search as inherent feature of database [Achacoso, database, col 5 lines 26-45].

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thong Vu*, whose telephone number is (571)-272-3904. The examiner can normally be reached on Monday-Thursday from 6:00AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Andrew Caldwell*, can be reached at (571) 272-3868. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Thong Vu*  
*Primary Examiner*  
*Art Unit 2142*

